

**Remarks**

This Amendment is in response to the Office Action dated **June 7, 2007**.

In the Office Action, the Office rejected claims 1, 5, 6, 12 – 14, and 17 under 35 U.S.C. § 102(b), alleging the same to be anticipated by U.S. Patent No. 4,597,755 to Samson et al. (hereafter “Samson”).

The Office rejected claims 2 – 4 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 4,665,925 to Millar (hereafter “Millar”).

The Office rejected claims 7 – 9 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 6,395,008 to Ellis et al. (hereafter “Ellis”).

The Office rejected claims 10 and 11 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Ellis and further in view of U.S. Patent No. 5,728,065 to Follmer et al. (hereafter “Follmer”).

The Office rejected claim 15 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Follmer.

The Office rejected claim 16 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Follmer and further in view of U.S. Patent No. 5,906,606 to Chee et al. (hereafter “Chee”).

The Office rejected claim 18 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 6,447,522 to Gambale et al. (hereafter “Gambale”).

The Office rejected claims 19 and 20 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 5,951,585 to Cathcart et al. (hereafter “Cathcart”).

The Office rejected claim 21 – 24 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 5,766,203 to Imran et al. (hereafter “Imran”).

Finally, the Office rejected claims 25 and 26 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of U.S. Patent No. 6,514,228 to Hamilton et al. (hereafter “Hamilton”).

Applicants note with appreciation that the drawing submitted previously was accepted by the Office.

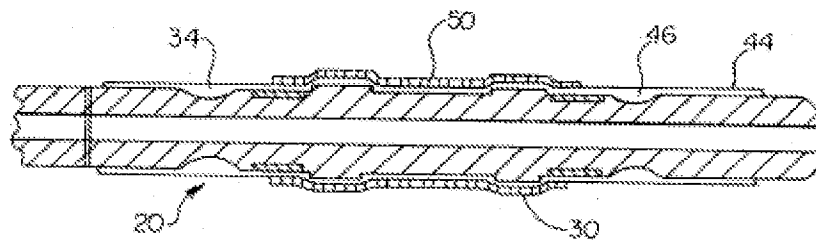
The following comments are presented in the same order and with headings and paragraph numbers corresponding to those set forth in the Office Action.

### **Claim Rejections—35 U.S.C. § 102**

The Office rejected claims 1, 5, 6, 12 – 14, and 17 under 35 U.S.C. § 102(b), alleging the same to be anticipated by Samson. Applicants respectfully disagree.

5. Samson fails to teach or suggest all the limitations of amended claim 1. Claim 1 includes the limitation, “the recessed portion oriented beneath the balloon distal cone portion, in an unexpanded state at least a portion of the balloon being stored in the recessed portion”. As stated in the specification at paragraph [0051], “Recessed portions 34 in the catheter tip 20 may be located to act as a storage recess for portions of the balloon, for example the conical portions 46, thereby allowing the catheter tip assembly to have a lower profile in those sections.” [Emphasis added]. And, FIG. 4, for example, of the instant application shows recessed portions 34 acting as storage recesses for portions 46 of the balloon 44, as shown below:

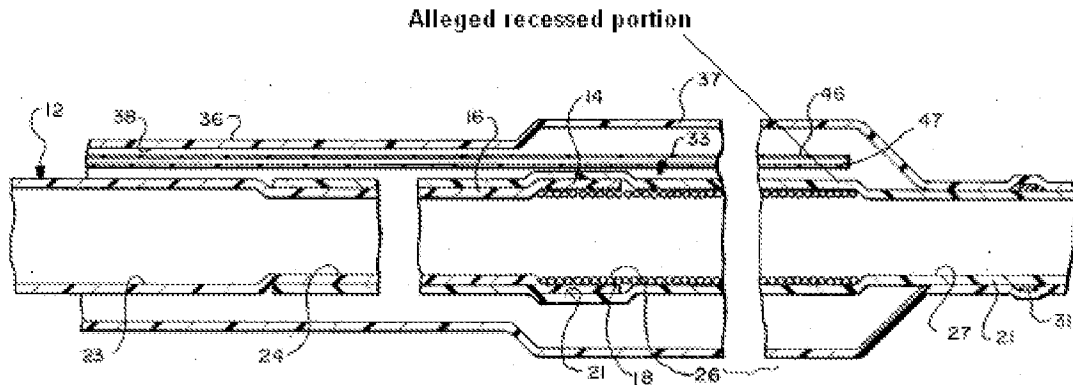
***Fig.4***



In *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), the Court held that the specification should be consulted prior to looking at extrinsic sources. In construing the term “recessed portion”, one of ordinary skill in the art would recognize from reading the specification and referring to the drawings of the present application that in order for portions of the balloon to be stored in the recessed portion, the recessed portion must extend ***inwardly***, as in FIG. 4.

This is in contrast to the section of the catheter of Samson that the Office alleges

to be the recessed portion. That portion of Samson *is not* configured such that “in an unexpanded state at least a portion of the balloon being stored in the recessed portion,” as recited in amended claim 1. Shown below is a *marked up* version of FIG. 2 of Samson:



**FIG. -2**

As shown above, the portion of Samson corresponding to the recessed portion of the instant application (as asserted by the Office) extends *outwardly*. As such, in an unexpanded state the balloon 37 in Samson would not be “stored in the recessed portion,” unlike in claim 1 of the instant application. That is, the portion where the spring 18 rests extends outwardly, *opposite* the direction the recessed portion of the instant application, thereby preventing any portion of the balloon from being “stored in the recessed portion”, as recited in claim 1. To that end, Samson does not teach or suggest all the elements of claim 1. As such, Samson is not anticipatory.

6. – 10. Because claims 5, 6, 12 – 14, and 17 depend from claim 1, they incorporate all the subject matter of claim 1 and add additional subject matter, making them all the more patentable over Samson. Applicants respectfully request removal of the Samson reference and that claims 1, 5, 6, 12 – 14, and 17 be allowed.

### **Claim Rejections—35 U.S.C. § 103**

13. – 14. The Office rejected claims 2 – 4 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Millar. Applicants respectfully disagree.

As argued above, Samson fails to teach or suggest all the elements of claim 1,

from which claims 2 – 4 depend. The addition of any alleged disclosure in Millar of markers does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Millar, the purported combination would still fail to produce the embodiments of the invention claimed in claims 2 – 4. Applicants respectfully request that the rejections be removed and that claims 2 – 4 be allowed.

15. – 17. The Office rejected claims 7 – 9 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Ellis. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claims 7 – 9 depend. The addition of any alleged disclosure in Ellis of hub portions does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Ellis, the purported combination would still fail to produce the embodiments of the invention claimed in claims 7 – 9. Applicants respectfully request that the rejections be removed and that claims 7 – 9 be allowed.

18. The Office rejected claims 10 and 11 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Ellis and further in view of Follmer. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claims 10 and 11 depend. The addition of any alleged disclosure in Follmer of markers flush with the outer surface of a catheter tip does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Ellis and Follmer, the purported combination would still fail to produce the embodiments of the invention claimed in claims 10 and 11. Applicants respectfully request that the rejections be removed and that claims 10 and 11 be allowed.

19. The Office rejected claim 15 under 35 U.S.C. § 103(a), alleging the same to be

unpatentable over Samson in view Follmer. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claim 15 depends. The addition of any alleged disclosure in Follmer of a first region having a greater flexibility than a second region does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Follmer, the purported combination would still fail to produce the embodiments of the invention claimed in claim 15. Applicants respectfully request that the rejections be removed and that claim 15 be allowed.

20. – 21. The Office rejected claim 16 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Follmer and further in view of Chee. Applicant respectfully disagrees.

Amended claim 16 includes the limitation, “the recessed portion oriented beneath the balloon distal cone portion, in an unexpanded state at least a portion of the balloon being secured in the recessed portion.” As argued above with regards to claim 1, Samson fails to teach or suggest this limitation. The addition of any alleged disclosure in Follmer of a first region having greater flexibility than a second region does nothing to address the failure of Samson to teach or suggest all the elements of claim 16. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Follmer and Chee, the purported combination would still fail to produce the embodiment of the invention claimed in claim 16. Applicants respectfully request that the rejections be removed and that claim 16 be allowed.

22. The Office rejected claim 18 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Gambale. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claim 18 depends. The addition of any alleged disclosure in Gambale of heat bonding a catheter tip to a catheter shaft does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Gambale, the purported combination would still fail to produce the embodiments of the invention claimed in claim 18. Applicants respectfully request

that the rejections be removed and that claim 18 be allowed.

23. The Office rejected claims 19 and 20 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Cathcart. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claims 19 and 20 depend. The addition of any alleged disclosure in Cathcart of RF welding or adhering a catheter tip to a catheter shaft does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Cathcart, the purported combination would still fail to produce the embodiments of the invention claimed in claims 19 and 20. Applicants respectfully request that the rejections be removed and that claims 19 and 20 be allowed.

24. – 27. The Office rejected claim 21 – 24 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Imran. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which claims 21 – 24 depend. The addition of any alleged disclosure in Imran of a stent delivery catheter having a stent does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Imran, the purported combination would still fail to produce the embodiments of the invention claimed in claims 21 – 24. Applicants respectfully request that the rejections be removed and that claims 21 – 24 be allowed.

28. The Office rejected claims 25 and 26 under 35 U.S.C. § 103(a), alleging the same to be unpatentable over Samson in view of Hamilton. Applicant respectfully disagrees.

As argued above, Samson fails to teach or suggest all the elements of claim 1, from which amended claim 25 and claim 26 depend. The addition of any alleged disclosure in Hamilton of including a catheter tip with sides, including a triangular shape, does nothing to address the failure of Samson to teach or suggest all the elements of claim 1. Therefore, even if there was some teaching, suggestion, or motivation to combine Samson with Hamilton, the purported combination would still fail to produce the embodiments of the invention claimed in

claims 25 and 26. Applicants respectfully request that the rejections be removed and that claims 25 and 26 be allowed.

**Conclusion**

For at least the reasons presented above, Applicants believe the application is in condition for allowance. Favorable consideration and early action to that effect are solicited earnestly.

Should the Examiner have any questions regarding the Amendment, the Examiner is invited to contact the Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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Date: August 7, 2007

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